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| APPLICATION NO.   | FILING DATE  | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|--------------|----------------------|---------------------|------------------|
| 09/940,767  | 08/27/2001   | Arnold M. Lund       | 020366-074100US     | 6793             |
| 20350   | 7590         | 01/14/2004           | EXAMINER            |                  |
| TOWNSEND AND TOWNSEND AND CREW, LLP<br>TWO EMBARCADERO CENTER<br>EIGHTH FLOOR<br>SAN FRANCISCO, CA 94111-3834 |              |                      | YANG, CLARA I       |                  |
| ART UNIT  | PAPER NUMBER |                      |                     |                  |
|   | 2635         |                      |                     |                  |
| DATE MAILED: 01/14/2004   |              |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/940,767             | LUND, ARNOLD M.     |  |
|                              | Examiner<br>Clara Yang | Art Unit<br>2635    |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 27 August 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 August 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>02</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

### *Specification*

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because the phrase "According to the invention" can be implied. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities:

- ◆ Page 3, line 17: Change "informaton" to "information".
- ◆ Page 7, line 19: "decides if the UMS should be page should be returned or ignored" is not in proper idiomatic English.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 - 4, 6, 8 - 12, 14, 16, 17, and 19 - 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,703,570 (Gorday et al.).

Referring to Claims 1 and 10, Gorday teaches a method comprising the steps of: (a) system controller 102 receiving a message intended for a portable subscriber unit (PSU) 106 from a remote sender (i.e., "pagor") via telephone 101, facsimile machine 120, or messaging terminal 122 (see Col. 3, lines 50 - 55 and 60 - 65); (b) system controller 102 sending the page wirelessly to the intended PSU 106 (i.e., "pager") via transmitter/receiver 103 (see Fig. 1 and Col. 5, lines 11 - 16); (c) system controller 102 determining if a predetermined time limit for a response, such as an acknowledgment (ACK) or a non-acknowledgment (NACK), from PSU 106 has been exceeded (see Fig. 4, step 416); (d) system controller 102 converting the outbound message received from a message input device to a page message (see Col. 3, lines 60 - 65 and Col. 5, lines 11 - 16); and (e) processing system 204 of system controller 102 storing the page message and changing the status of the page message from "delivery pending" to "undelivered" when the time limit for a response and the number of retransmissions have been exceeded (see Fig. 4, steps 416, 430, and 424; and Col. 10, lines 14 - 25 and 46 - 55). Per Gorday, PSU 106 is one of several types of devices, including two-way pagers (see Col. 5, lines 34 - 35). It is understood that changing the status of the page message from "delivery pending" to "undelivered" by processing system 204 is equivalent to "activating a message-waiting indicator".

Regarding Claim 2, Gorday's system controller 102 includes an outbound message memory 208 for storing pending and undeliverable messages for PSUs 106 (see Fig. 2; Col. 5, lines 60 - 63; Col. 6, lines 24 - 30; and Col. 10, lines 14 - 20).

Regarding Claims 3 and 11, as described above in Claims 1 and 10, Gorday's radio communication system 100 enables PSUs 106 to receive messages from telephones, facsimile machines, and messaging terminals, which are devices other than pagers. This is accomplished by Gorday's system controller 102, which (1) receives messages from telephones, facsimile machines, and messaging terminals, (2) encodes the outbound messages intended for PCU 106, (3) stores a queue of the encoded outbound messages in message memory 208, (4) transmits the outbound messages to PSUs 106, and (5) stores the undeliverable outbound messages in message memory 208 (see Fig. 4, steps 408 and 424; Col. 5, lines 11 - 16; Col. 6, lines 24 - 30; and Col. 10, lines 14 - 25 and 46 - 52). Consequently, Gorday's system controller 102 and transmitter/receiver 103 are understood to form a unified messaging system.

Regarding Claims 4 and 12, as explained above in Claims 1 and 10, processing system 204 only changes the status of an outbound message from "delivery pending" to "undelivered" when (1) the time limit for a response and number of retransmissions have been exceeded and (2) the number of retransmissions have been exceeded (see Fig. 4, steps 416, 430, and 424; and Col. 10, lines 14 - 25 and 46 - 55). Here it is understood that the maximum allowable number of retransmissions is a predetermined criterion.

Regarding Claims 6 and 14, Gorday imparts that when the intended PSU 106 receives an outbound message transmitted by system controller 102, a user (or "pagee") can use PSU 106 to generate and transmit an inbound response back to system controller 102. System controller 102's message handler function identifies the inbound response as having been generated by the

user specifically in response to the outbound message and generates another message that is sent to the originator (i.e., "pagor") of the outbound message to notify the originator that the outbound message has been acknowledged and responded to by PSU 106. (See Col. 6, lines 35 – 52.) In order for a user to respond to the originator's outbound message via PSU 106, system controller 102 must store information relating to the originator's communication mode that can be used by PSU 106 to send a response to the originator.

Regarding Claims 8, 9, 16, 17, 20, and 21, as explained above in Claims 1 and 10, Gorday's processing system 204 of system controller 102 stores an outbound page message and changes the status of the page message from "delivery pending" to "undelivered" (i.e., "message-waiting indicator") when the time limit for a response and the number of retransmissions have been exceeded (see Fig. 4, steps 416, 430, and 424; and Col. 10, lines 14 – 25 and 46 – 55). Consequently, the message-waiting indicator is remote to PSU 106. Referring to Fig. 2, Gorday's processing system 204 includes a conventional computer system 212 and mass storage media 214, wherein the functions of processing system 204 are executed by computer system 212 and controlled by a set of program instructions stored in mass storage media 214 (see Col. 7, lines 2 – 14 and 22 – 30).

Regarding Claim 19, as discussed in Claims 6 and 14, in order for a user (i.e., "pagee") to respond to an originator's (i.e., "pagor") outbound message via PSU 106, system controller 102 must store information relating to the originator's communication mode that can be used by PSU 106 to send a response to the originator. Consequently, Gorday's method further includes the steps of: (a) system controller 102 (i.e., "the unified messaging system") receiving PSU 106's response to a received outbound message; (b) system controller 102's message handler function identifying the inbound response as having been generated by the user specifically in response

to the outbound message and generates another message to be sent to the originator for notifying the originator that the outbound message has been acknowledged and responded to by PSU 106; and (c) system controller 102's message handler function retrieving the originator's communication mode information from memory and routing the new outbound message according to the retrieved information. (See Col. 6, lines 7 - 16 and 35 - 52.)

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 7, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,703,570 (Gorday et al.) as applied to claims 1 and 10 above, and further in view of U.S. Patent No. 5,974,300 (LaPorta et al.).

Regarding Claims 5 and 13, Gorday omits teaching the step of system controller 102 receiving from a page sender (i.e., the "originator" or "pagor") at least one of a plurality of predetermined messages that is to be sent to an intended PSU 106.

In an analogous art, LaPorta teaches a two-way wireless messaging system 10, as shown in Figs. 1 and 2, including (a) two-way messaging network 14 or unified messaging system and (b) a plurality of two-way messaging devices, such as telephone 22, computer 27, and pager 44 (see Col. 5, lines 29 - 33). LaPorta's method, as shown in Fig. 7, comprises a sender (S) 200 or pagor transmitting a message (PG2BS-NEW), which contains the address of S, an array of recipient addresses, an array of reply-to addresses, and the coded message, to the

communications network via batcher server (BS-S) 208 (see Col. 14, lines 41 - 46). PG2BS-NEW is forwarded to the sender's user agent (UA-S) 212 via message server (MS) 210, wherein UA-S 212 expands the message and contacts the user agents of the message recipients in order to determine the location of the recipients' messaging devices, the format in which the recipients wish to receive the message, and their status (see Col. 14, lines 54 - 67 and Col. 15, lines 1 - 12). After MS 210 receives the information from the recipients' user agents, MS 210 forwards the full message, along with the list of recipients, their desired message formats, and last known locations to distribution server (MS2DS) 221, which determines how to deliver the message to the recipients (see Col. 15, lines 28 - 33). LaPorta's unified messaging system includes a message storage server for storing messages when it is determined that a recipient's messaging device is inactive (see Col. 15, lines 15 - 16 and 36 - 67). Once the recipient's messaging device is active, the recipient's messaging device receives a retrieval ID from the user agent for retrieving the stored message (see Col. 15, lines 47 - 51). Per LaPorta, two-way wireless messaging system 10 supports various types of messages, such as pre-canned or predetermined messages (see Col. 13, lines 55 - 67 and Col. 14, lines 1 - 20); hence it is understood that message PG2BS-NEW is one of a plurality of pre-canned messages.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Gorday as taught by LaPorta because the step of transmitting at least one of a plurality of pre-canned messages enables the sender (i.e., "pagor") to send messages with limited input, thereby making message generation easy and practical, especially when the messaging device has little or no input means (see LaPorta, Col. 13, lines 47 - 52).

Regarding Claims 7 and 15, though Gorday's system controller 102 is able to store one communication mode that is used when a user (or "pagee") responds via PCU 106 to an originator's outbound message, Gorday is silent on system controller 102 storing information relating to a plurality of communications modes for the originator.

LaPorta's unified messaging system, as shown in Fig. 4, has user agents 12 that store the last known location of their corresponding messaging devices, the format in which the message is to be received, and the status of each messaging device (see Col. 15, lines 6 - 9). When a message recipient responds to an originator's message, messaging server 114 contacts originator's user agent 12 to determine where to deliver the responses (see Col. 16, lines 27 - 30). Because the originator's message includes an array of reply-to addresses (see Col. 14, lines 41 - 46), it is understood that the array reply-to addresses (or "plurality of communication modes) is stored in the originator's user agent 12 in order for user agent 12 to instruct messaging server 114 where to deliver the responses.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Gorday as taught by LaPorta because the step of system controller 102 storing a plurality an originator's reply-to addresses that can be used when a user responds to an originator's message improves the likelihood of the originator receiving the responses, thus improving radio communication system 100's performance.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,703,570 (Gorday et al.) in view of U.S. Patent No. 5,974,300 (LaPorta et al.).

Gorday teaches a method comprising the steps of: (a) system controller 102 receiving a message intended for a portable subscriber unit (PSU) 106 from a remote sender (i.e., "pagor") via telephone 101, facsimile machine 120, or messaging terminal 122 (see Col. 3, lines 50 - 55

and 60 – 65); (b) system controller 102 sending the page wirelessly to the intended PSU 106 (i.e., “pager”) via transmitter/receiver 103 (see Fig. 1 and Col. 5, lines 11 – 16); (c) system controller 102 determining if a predetermined time limit for a response, such as an acknowledgment (ACK) or a non-acknowledgment (NACK), from PSU 106 has been exceeded (see Fig. 4, step 416); (d) system controller 102 converting the outbound message received from a message input device to a page message (see Col. 3, lines 60 – 65 and Col. 5, lines 11 – 16); and (e) processing system 204 of system controller 102 storing the page message and changing the status of the page message from “delivery pending” to “undelivered” when the time limit for a response and the number of retransmissions have been exceeded (see Fig. 4, steps 416, 430, and 424; and Col. 10, lines 14 – 25 and 46 – 55). Here it is understood that the maximum allowable number of retransmissions is a predetermined criterion and that changing the status of the page message from “delivery pending” to “undelivered” by processing system 204 is equivalent to “activating a message-waiting indicator”. As explained above in Claims 6 and 14, in order for a user to respond to the originator’s outbound message via PSU 106, Gorday’s method must also include the step of (f) system controller 102 storing information related to the originator’s communication mode that can be used by PSU 106 to send a response to the originator. Gorday omits teaching the step of system controller 102 receiving from a page sender (i.e., the “originator” or “pagor”) at least one of a plurality of predetermined messages that is to be sent to an intended PSU 106.

In an analogous art as described above in Claims 5 and 13, LaPorta’s two-way wireless messaging system 10 supports various types of messages, such as pre-canned or predetermined messages (see Col. 13, lines 55 – 67 and Col. 14, lines 1 – 20). Hence, LaPorta’s two-way wireless messaging network 14 or unified messaging system can receive at least one of a

plurality of pre-canned messages from a sender's (i.e., "pagor") two-way pager 50a, as shown in Fig. 3.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Gorday as taught by LaPorta because the step of transmitting at least one of a plurality of pre-canned messages enables the sender (i.e., "pagor") to send messages with limited input, thereby making message generation easy and practical, especially when the messaging device has little or no input means (see LaPorta, Col. 13, lines 47 - 52).

#### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- ◆ U.S. Patent No. 5,742,668 (Pepe et al.): Pepe teaches an electronic messaging network that provides a subscriber with the ability to remotely control the receipt and delivery of wireless and wireline electronic text messages. The subscriber's message receipt and delivery options are maintained in a personal communications internetworking (PCI) 40.
- ◆ U.S. Patent No. 6,061,570 (Janow): Janow teaches a unified message system and service that collects information about waiting messages and forwards the collected information to a multi-service notifying device.
- ◆ U.S. Patent No. 6,317,485 (Homan et al.): Homan teaches a unified messaging system that enables a subscriber to receive notification regardless of which communications network services receives the new message.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clara Yang whose telephone number is (703) 305-4086. The examiner can normally be reached on 8:30 AM - 7:00 PM, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

CY  
8 January 2004



BRIAN ZIMMERMAN  
PRIMARY EXAMINER